

### **REMARKS**

Claims 1-6, 8-10, 12-18 are pending in this Application, with Claims 7, 11, 19 canceled, with Claims 1, 8, 9, 14 being amended and Claims 21-23 being added. No new matter is added by way of these amendments, and the amendments are supported throughout the Specification and the drawings. Reconsideration of Claims 1-6, 8-10, 12-18 and favorable consideration of Claims 21-23 is respectfully requested. The Examiner's rejections will be considered in the order of their occurrence in the Official Action.

#### **Paragraphs 1-2 of the Official Action**

The Official Action rejected Claims 1-10, 12-20 under 35 U.S.C. §103(a) as being unpatentable over Frisbee (U.S. Patent No. 4,405,019). The Applicant respectfully disagrees with this rejection of these claims for at least the following reasons.

##### ***i. Burden on Examiner to Establish Prima Facie Case***

In proceedings before the United States Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art.<sup>1</sup> When references cited by the Examiner fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned upon appeal.<sup>2</sup> "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references."<sup>3</sup>

"To establish a *prima facie* case of obviousness, three basic criteria must be met."<sup>4</sup> First, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

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<sup>1</sup> *In re Bell*, 26 USPQ2d 1529, 1530 (Fed. Cir. 1993). *In re Oetiker*, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

<sup>2</sup> *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

<sup>3</sup> *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

<sup>4</sup> MPEP §706.02(j).

combine reference teachings. Second, there must be a **reasonable expectation of success**. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.<sup>5</sup>

**ii. Legal Requirements for Obviousness**

“Precedent requires that to find a combination obvious there must be some teaching, suggestion, or motivation in the prior art to select the teachings of separate references and combine them to produce the claimed combination.”<sup>6</sup> “An explicit teaching that identifies and selects elements from different sources and states that they should be combined in the same way as in the invention at issue, is rarely found in the prior art.”<sup>7</sup> “As precedent illustrates, many factors are relevant to the motivation-to-combine aspect of the obviousness inquiry, such as the **field of the specific invention**, the **subject matter of the references**, the extent to which they are **in the same or related fields of technology**, the **nature of the advance** made by the applicant, and the **maturity and congestion of the field**.”<sup>8</sup> Obviousness requires proof “that the skilled artisan ... would select the elements from the cited prior art references for combination in the manner claimed.”<sup>9</sup>

<sup>5</sup> *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

<sup>6</sup> *In re Johnston*, 435 F.3d 1381, 2006 WL 213719 (Fed. Cir. 2006) (citing *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1385 (Fed. Cir. 2001) (“In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention.”); *In re Dance*, 160 F.3d 1339, 1343 (Fed.Cir.1998) (“When the references are in the same field as that of the applicant's invention, knowledge thereof is presumed. However, the test of whether it would have been obvious to select specific teachings and combine them as did the applicant must still be met by identification of some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention.”); *In re Fine*, 837 F.2d 1071, 1075 (Fed.Cir.1988) (there must be “some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed.Cir.1985) (“When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.”).

<sup>7</sup> *Id.*

<sup>8</sup> *Id.*

<sup>9</sup> *In re Rouffet*, 149 F.3d 1350, 1358 (Fed.Cir.1998).

It is further submitted that combining elements from different prior art references must be motivated or suggested by the prior art.

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

*In re Fritch*, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious -- there must be a motivation provided by the prior art.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape \*\*\* since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

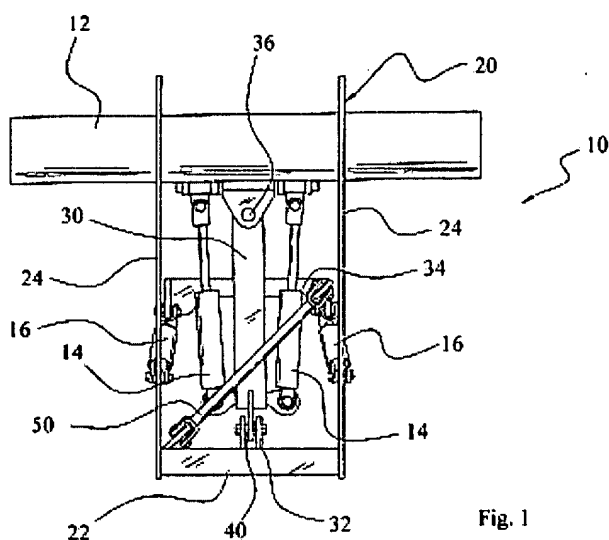
*Ex parte Gerlach and Woerner*, 212 USPQ 471 (PTO Bd. App. 1980) (emphasis in original).

### *iii. Analysis*

Added independent Claim 21 is comprised of the features of the originally filed independent Claim 1 with no changes. Claim 21 has the following features:

21. An implement mounting system, comprising:  
**a support frame (20);**

a ball joint (40) attached to said support frame;  
 a support arm (30) having a first end and a second end, wherein said first end is attached to said ball joint and wherein said second end receives an attachment structure for an implement (12); and  
 a brace member (50) attached between said support frame (20) and said support arm (30).

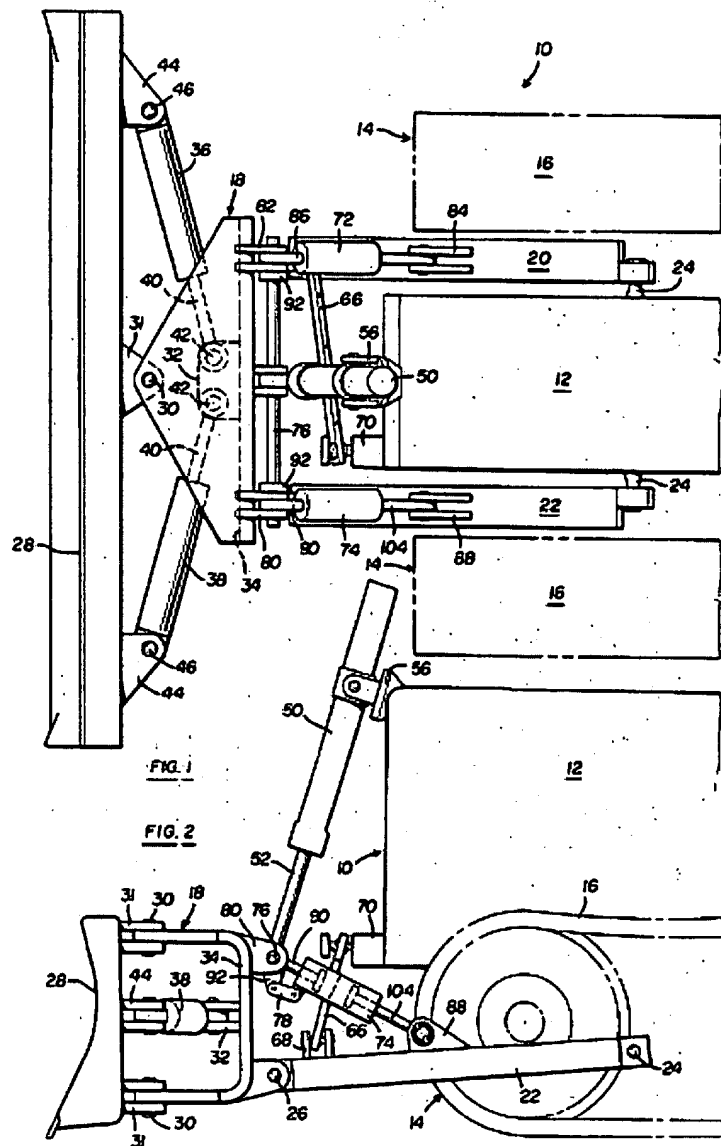


**Figure 1 of Present Invention**

The Office Action states that Frisbee discloses “a support arm (seen as cylinder 50).” (Office Action, Page 2.) However, the “hydraulic actuator 50” is not a “support arm” – the hydraulic actuator is for lifting and lowering the blade (“... blade 28 is raised and lowered by a conventional hydraulic actuator 50 supported on the front end of main frame 12 and having a piston rod 52 pivotally connected on the back of frame 18 at lugs 54 ...”). The “hydraulic actuator 50 in Frisbee does not teach or suggest using a support arm as claimed in the present invention.

In addition, the Office Action states that Frisbee discloses “a brace member (seen as link 66) attached between the support frame and the support arm.” (Office Action, Page 2.) However, as clearly shown in Figure 2 of Frisbee the “link 66 [is] interconnected between tractor 10 and one of the push arms 20 or 22.” (Column 5, Lines 3-5.) Therefore, Frisbee does not teach a brace member attached between the support frame and the support arm. The claimed

feature of “a brace member (50) attached between said support frame (20) and said support arm (30)” is a significant feature of the present invention that is claimed in independent Claim 1. More particularly, the brace member 50 of the present invention is utilized “*for stabilizing the horizontal side-to-side movements of the support arm 30.*” (Application, Page 12.) Frisbee does not teach or suggest this feature of the present invention.



*Figures 1 and 2 of Frisbee*

For these reasons, among others, Frisbee cannot suggest the combination of features in the applicant's Claim 21 and it is therefore submitted that the rejection against these claims should be withdrawn and Claims 21-23 allowed.

**Paragraph 3 of the Official Action**

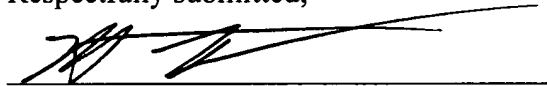
The Applicant has amended independent Claims 1, 14 to include “*wherein said brace member is attached to a cross member, wherein said cross member is attached transversely to said support arm, wherein said cross member is attached to a central location upon said support arm.*” Pursuant to Paragraph 3 of the Office Action, independent Claims 1, 14 (along with their respective dependent claims) are deemed to be in condition for allowance.

**CONCLUSION**

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited. Should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, they are invited to telephone the undersigned.

In addition, it is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Respectfully submitted,



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Date

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